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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,816	02/14/2001	David J. Sharp	UC069.001A	1726

20995 7590 11/18/2002

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EXAMINER

YAEN, CHRISTOPHER H

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 11/18/2002

92

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,816

Applicant(s)

SHARP ET AL.

Examiner

Christopher H Yaen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed 8/6/02 (paper no. 10) is acknowledged and entered into the record. Applicant has elected group I (claims 1-11, and 15) without traverse. Applicant also elects SEQ ID No: 1, in which X1 is SEQ ID No: 3, X2 is L, and X3 is SEQ ID No: 22. Upon further review and reconsideration, the prior office action is vacated in view of a new restriction requirement. As a result, canceled claims will be reconsidered in the instant restriction.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-3,9-11,15,17, and 21-22, drawn to a peptide, a peptide in a pharmaceutically acceptable carrier, and a method of inhibiting cellular proliferation classified in class 530, subclass 300. Furthermore, applicant must elect a single SEQ ID Number to be examined on the merits. This is not a species election (see below for explanation).
 - II. Claims 4, 6, and 18, drawn to a peptide having sequence identity to SEQ ID No: 51 and a method of inhibiting cellular proliferation, classified in class 530, subclass 300.
 - III. Claims 5, 7, and 19, drawn to a peptide having sequence identity to SEQ ID No: 52 and a method of inhibiting cellular proliferation, classified in class 530, subclass 300.

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- IV. Claims 8 and 20, drawn to a nucleotide sequence that hybridizes under stringent conditions and a method of inhibiting cellular proliferation, classified in class 536, subclass 23.1.
- V. Claims 12-14, and 16 drawn to nucleic acid, a vector, a host cell, and a composition comprising a nucleic acid and a carrier classified in class 536, subclass 23.1.
- VI. Claims 1 and 23-27 drawn to a peptide and a method of identifying a compound capable of inhibiting cellular proliferation, classified in class 530, subclass 300. Furthermore, applicant must elect a single SEQ ID Number to be examined on the merits. This is not a species election (see below for explanation).

The inventions are distinct, each from the other because of the following reasons:

- 3. The inventions of groups I-VI differ one from the other because the inventions are drawn to products that have different chemical structures, functions, and have different effects. For example the peptide of group I differs from the peptides of groups II and III because the amino acid sequences are different. As such the function of the different proteins are different and distinct.
- 4. Because these inventions are distinct for the reasons given above and the search required for the different groups are not require one for the other. Furthermore, the searches require a search in different databases which are not overlapping and are not co-extensive, therefore, restriction for examination purposes as indicated is proper.

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5. Upon election of Group I or VI, Applicants are additionally required to elect a single Sequence identified by a specific sequence identification number, as indicated above as they apply to group(s). The recited sequences have different structures one from other and the search for the sequences would be unduly burdensome. This requirement is not to be construed as a requirement for an election of species, since each of the sequence(s) recited in alternative form is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention. The claims are drawn to a sequence formula or motif, of which there are several variables to complete the formula. Because the specific sequence has not been provided and because a search for the all the possible permutations would require undue search, Applicant must select one sequence that fulfills that sequence formula or motif.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

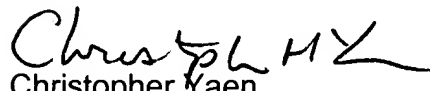
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 703-305-3586. The examiner can normally be reached on Monday-Friday 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Christopher Yaen
Art Unit 1642
November 18, 2002


ALI R. SALIMI
PRIMARY EXAMINER